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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,670	09/22/2003	Mark C. Nicely	14522-002002	1055
26181	7590	02/26/2007	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			SAGER, MARK ALAN	
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/668,670	NICELY ET AL.
	Examiner M. A. Sager	Art Unit 3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 March 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-59 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-59 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                       |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>Mar 12, 2004</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Claim Objections***

1. Claim 21 is objected to because of the following informalities: phrasing ‘first and second selected number of consecutive main rounds are equal and are first and second streak rounds are in play during a single main round’. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language ‘first and second selected number of consecutive main rounds are equal and are first and second streak rounds are in play during a single main round’ is confusing at least due to phrasing is unclear as to metes and bounds of invention. For examination purposes, the language is read as --first and second selected number of consecutive main rounds are equal and are first and second streak rounds, the first and second streak rounds are in play during a single main round--.

***Claim Interpretation***

4. The invention defined by claim language regarding first, second and/or third wager or streak round (or similar) fails to preclude wagers by multiple players/bettors over successive or simultaneous rounds of play. Further, only claims 7-8, 20, 45-46 and 56 appear to require first and second (or third) wagers to be simultaneous, but also fail to preclude wagers from multiple parties. For example, broadest reasonable interpretation of claimed invention apparatus is a counter or mechanism for counting or displaying status of consecutive events.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13, 16-23, 25-27, 29, 31, 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein (5718431). Orenstein discloses a system and method to manually record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game (abstract, 1:59-2:62, 3:15-4:67, 5:28-6:37, figs. 1-6) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did

not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein '431 discloses an apparatus (fig 1-6) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 2-3e) teaching all claimed structure.

7. Claims 1-13, 16-28, 30, 38-51, and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein (5788574 or 5570885). Orenstein '574 incorporates Orenstein '885 by reference thus discussion follows from Orenstein '885; however, other citations may apply. Orenstein '885 discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 1:43-2:47, 3:18-6:61, figs. 1-8) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, 1:43-2:47, figs. 1-8), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, 1:43-2:47, figs. 1-8), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, 1:43-2:47, figs. 1-8), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main

rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein ‘885 discloses an apparatus (fig 1-8) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 1-8, ref 15, 46, 76) teaching all claimed structure.

8. Claims 1-4, 6-10, 12-13, 15-33, 37-42, 44-48, 50-51, 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Forte (5586766). Forte discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 3:65-16:36, figs. 1-21) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), receiving an outcome and determining whether outcome is same as selected type

for first and second streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Forte discloses an apparatus (fig 1-21) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620) teaching all claimed structure.

9. Claims 1-13, 15-28, 30-32, 34-35, 37-51, 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinberg (5851010). Feinberg discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a

plurality of players at/on a table game or electronic game apparatus (abstract, 1:27-41, 2:31-8:49, figs. 1-4) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, 3:23-35, fig. 1), receiving an outcome (fig. 1, block 40) and determining whether outcome is same as selected type for first and second streak round (abstract, fig. 1), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, fig. 1-4), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Feinberg discloses an apparatus (fig 1-4) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-4) teaching all claimed structure.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 14, 34-35, 52 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Feinberg. Feinberg discloses invention including tracking consecutive [strike] events (figs 1-4) on a game table (figs. 1-4, esp. 1 and 3) or by gaming machine that would be done electronically or electromechanically (fig. 1

and 3) which clearly fig 3 depicts a graphical image of progress. Alternatively, Feinberg does not particularly describe a graph or bar graph as claimed. Although the representation of progress of consecutive events taught by Feinberg is not a graph or bar graph, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of claimed invention in that the claimed graph or bar graph fails to patentably distinguish. A graph or bar graph provides an easy visual indication and thus would be obvious to add to Feinberg so as to provide an easy visual indication of state of game including illustration of progress of streak round/wager.

14. Claim 33-34, 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg. Feinberg lacks arc, chart and pie chart. Although the representation of progress of consecutive events taught by Feinberg is not a chart or pie chart, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of claimed invention in that the claimed chart or pie chart fails to patentably distinguish. A chart or pie chart provides an easy visual indication and thus would be obvious to add to Feinberg so as to provide an easy visual indication of state of game including illustration of progress of streak round/wager. Regarding arc, a pie chart provides an arc, or alternatively, arc is a decorative or ornamental arrangement that fails to patentably distinguish over Feinberg's display (fig. 1-4).

### *Conclusion*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

Art Unit: 3712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager  
Primary Examiner  
Art Unit 3712

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